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In re Application of:	:	
BEER, Robert, et al.	:	DECISION
U.S. Application No.: 10/561,134	:	
PCT No.: PCT/EP2004/006711	:	
International Filing Date: 22 June 2004	:	
Priority Date: 26 June 2003	:	
Atty Docket No.: ICH 303-US	:	
For: OPTICAL INTENSIFIER	:	
MATERIALS	:	

This decision is issued in response to the "Response To Notification Of Missing Requirements" filed 19 May 2006, treated herein as a petition under 37 CFR 1.181 to confirm the timely filing of an English translation of the international application. No petition fee is required.

BACKGROUND

On 22 June 2004, applicants filed international application PCT/EP2004/006711. The international application claimed a priority date of 26 June 2003, and it designated the United States. On 06 January 2005, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 26 December 2005. The published international application included 13 claims.

On 15 December 2005, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee, a purported translation of the international application into English, and an executed declaration. The English translation of the international application filed on 15 December 2005 included 20 claims.

On 16 March 2006, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) indicating that the translation of the international application filed on 15 December 2005 was defective based on the disparity between the number of claims listed in the translation and the number of claims contained in the international application. The Notification required submission of a proper translation and the processing fee required for filing the translation later than thirty months after the priority date.

On 19 May 2006, applicants filed the response to the Notification Of Missing requirements considered herein, accompanied by a translation of the original 13 claims contained in the international application. The submission argues that the translation filed 15 December 2005 should be accepted as a proper translation of the international application as filed, and that applicants should therefore not be required to pay the processing fee required for late submission of a translation.

DISCUSSION

37 CFR 1.495(c)(1)(i) requires national stage applicants to file a “translation of the international application, as filed, into the English language.” Pursuant to 37 CFR 1.495(c)(3), the “payment of the processing fee set forth in § 1.492(i) is required for acceptance of an English translation later than the expiration of thirty months after the priority date.”

Here, as noted above, the international application included 13 claims, while the translation filed 15 December 2005 included 20 claims. Applicants argue that the translated claims previously filed included all the language of the original claims (stating that the changes in the claims only involved the correction of multiple dependencies); however, as set forth in MPEP 1893.01(d) any changes in the translation, however minor, render the translation unacceptable:

The translation must be a translation of the international application as filed or with any changes which have been properly accepted under PCT Rule 26 or any rectifications which have been properly accepted under PCT Rule 91. A translation of less than all of the international application (e.g., a translation that fails to include a translation of text contained in the drawings or a translation that includes a translation of claims amended under PCT Article 19 or 34 but does not include a translation of the original claims) is unacceptable. In addition, a translation that includes modifications other than changes that have been properly accepted under PCT Rule 26 or 91 (e.g., a translation that includes headings that were not present in the international application as originally filed) is unacceptable. A translation of words contained in the drawings must be furnished either in the form of new drawings or in the form of a copy of the original drawings with the translation pasted on the original text matter. See PCT Rule 49.5(d). ... Amendments, even those considered to be minor or to not include new matter, may not be incorporated into the translation. If an amendment to the international application as filed is desired for the national stage, it may be submitted in accordance with 37 CFR 1.121.

Thus, regardless of whether the modifications incorporated in the translation only involved the moving of language from one claim number to another, the translation is still not an acceptable translation of the claims "as filed," as required by the regulation. Moreover, it is noted that, while the present submission states that the "English Translation submitted with the filing contained 15 claims," the translated claims filed herein on 15 December 2005 actually included 20 claims. Thus, it is possible that additional changes beyond those referred to herein may have been incorporated into the translated claims filed 15 December 2005.

Based on the above, the 20 translated claims filed 15 December 2005 cannot be accepted as a translation of the claims "as filed" in the international application. The required translation was not filed until applicants' 19 May 2006 submission of an English translation of the 13 claims contained in the international application, as filed. Because these materials were not filed until more than thirty months after the priority date, applicants are required to pay the \$130 processing fee for failure to file a proper translation within thirty months of the priority date.

Finally, it is noted that applicants have not submitted a proper preliminary amendment of the claims in compliance with 37 CFR 1.121, and the application file does not include an indication that these claims were amended during the international phase of the application. Accordingly, the claims of record remain the 13 claims set forth in the international application.

CONCLUSION

Applicants' petition under 37 CFR 1.181 to confirm the timely filing of an acceptable translation of the international application into English is **DISMISSED** without prejudice.

An acceptable translation of the claims contained in the international application as filed was included with the present submission filed 19 May 2006.

Based on the above, applicants are required to pay the \$130 processing fee for filing the translation later than thirty months after the priority date, as set forth in the Notification Of Missing Requirements mailed 16 March 2006. The present submission included the authorization to charge Deposit Account No. 50-1541 for this fee; however, when this charge was attempted, the Deposit Account did not include the necessary funds. Accordingly, applicants' response to the Notification Of Missing Requirements mailed 16 March 2006 is defective.

Applicants have **ONE (1) MONTH** from the mail date of this decision to submit payment of this \$130 processing fee. Failure to submit a timely and proper response will result in abandonment of the application.

EXTENSIONS OF TIME UNDER 37 CFR 1.136(a) ARE NOT AVAILABLE.

It is also noted that, if applicants desire to avoid additional claims fees based on the 13 claims of record (and the multiple dependencies contained therein), a proper Preliminary Amendment under 37 CFR 1.121 is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT,
Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents
of the letter marked to the attention of the Office of PCT Legal Administration.

A handwritten signature in black ink, consisting of a series of loops and a final vertical stroke, representing the name Richard M. Ross.

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